

REMARKS

Applicants appreciate the consideration shown by the Office as evidenced by the Office Action mailed on December 3, 2003. In that Office Action, the Examiner rejected claims 1-6, 17, 18, 22, 33-35, and 39-48, and objected to claims 7-16, 19-21, 25, 27-32, 36, and 37. In this response, Applicants have amended claim 1 and enclose a terminal disclaimer. Applicants respectfully request reconsideration of the application by the Examiner in light of the above amendments, the attached terminal disclaimer, and the following remarks offered in response to the Office Action.

1. Rejection under Kanai et al. in view of Matsukawa

Claims 42 to 48 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kanai et al. (JP Patent. 3566166386) in view of Matsukawa. (US Patent Number 5962145). Applicants respectfully traverse this rejection.

Applicants respectfully submit that the combination of these two references is improper. A proper combination of references requires some suggestion or motivation to combine the reference teachings. MPEP §2143. If a proposed combination of prior art references "would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification." MPEP §2143.01, citing *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Here, the Examiner contends that a modification of Kanai using the description of Matsukawa renders Applicant's claims 42-48 obvious. Applicants respectfully disagree. Kanai describes the use of a solution containing hydrosilicofluoric acid to remove lead oxide from a titanium substrate, "whereby the surface of the substrate is cleaned." Kanai, Abstract. Thus, in Kanai, the substrate is treated to remove any coating from its surface. In stark contrast, Matsukawa describes a solution containing this same acid in a "surface treatment method...for forming a film" on the surface of aluminum. Id. Thus in Matsukawa, the substrate is treated to dispose a coating on the substrate surface. To modify the cleaning method of Kanai with film-forming method of Matsukawa would render Kanai unsuitable for its intended purpose of producing a clean surface—the film formed in Matsukawa defeats the whole purpose of the cleaning process of Kanai.

The mere fact that the process discussed by Matsukawa involves, as but one of the mechanisms at work, some etching of material (col. 3, line 45 et seq.) does not provide the needed suggestion to make a proper combination with Kanai. "A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention." MPEP §2141.02, *citing W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), *cert. denied*, 469 US 851 (1984) (emphasis original). Here, in addition to etching the metal, the solution also reacts with the metal to form a film. This film-forming process is a portion of the reference that leads away from the cleaning process of Kanai, because one skilled in the art would not want to deposit a film on a surface that is to be treated to remove a coating. Taken as a whole, the main point of Matsukawa is this film-forming function of the solution—in fact, the Abstract of this reference clearly sets forth that Matsukawa provides "[a]n aluminum surface treatment...for forming a film" on a metal surface, in direct conflict with the cleaning solution discussed in Kanai. Applicants respectfully request that the rejection of claims 42-48 be removed due to a lack of a *prima facie* case of obviousness based upon this non-combinability of references.

2. Double Patenting Rejection

Claims 1 - 6, 17, 18, 22, 33 - 35, 39, 40, and 41 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 4, 9, 10, 13, and 28 - 35 of copending Application No. 09/682,862. Applicants herein attach a terminal disclaimer to overcome this rejection.

3. Amendment to claim 1

Applicants have amended claim 1 to make its scope more consistent with that of claim 34, in that the coatings to be removed are coatings comprising aluminides or MCrAl(X), irrespective of whether the coatings are deposited by a diffusion coating process or an overlay process. Applicants respectfully submit that this recitation is adequately supported in the specification and is allowable over the applied prior art.

4. Allowable Claims

Applicants note with appreciation the Examiner's remarks that claims 7-16, 19-21, 25, 27-32, 36, and 37 recite allowable subject matter. Applicants respectfully submit that as



Serial No. 09/591,531

RD-27,817-5

all of these claims depend directly or indirectly from claims rejected solely under the double patenting rejection described above, which Applicants have overcome by virtue of the attached terminal disclaimer, all of these claims are allowable as depending from an allowable base claim.

5. Conclusion

In light of the amendments and remarks presented herein, Applicants submit that the case is in condition for immediate allowance and respectfully request such action. If, however, any issues remain unresolved, the Examiner is invited to telephone the undersigned at the number provided below.

Respectfully submitted,

Paul DiConza
Reg. No. 48,418
General Electric Company
Building K1, Room 3A60
Telephone: (518) 387-6131

Schenectady, New York
Friday, February 27, 2004

RECEIVED
MAR 09 2004

Attachment: Terminal Disclaimer